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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/941,869 | 08/30/2001 | Pascal Arnaud | 212527US0 | 7528 |
| 22850 | 7590 | 02/09/2006 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | YU, GINA C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 09/941,869 | Applicant(s) ARNAUD, PASCAL | |
| | Examiner Gina C. Yu | Art Unit 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 16, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-28, 31-42, 44-51, 53-58, 60-79, 81-95 and 101-112 is/are pending in the application.
- 4a) Of the above claim(s) 53-57, 60, and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-28, 31-42, 44-51, 58, 62-79, 81-95, and 101-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment filed on November 16, 2005. Claims 2-28, 31-42, 44-51, 53-58, 60-79, 81-95, and 101-112 are pending, and claims 53-57, 60, and 61 have been withdrawn from consideration. Claim rejections made as indicated in the previous Office action dated May 16, 2005, are withdrawn in view of claim amendment made by applicants. New rejections are made as below.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, and 101-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima (EP 0548694 A1) in view of Mellul (US 5738841).

Nojima teaches long-lasting, oil-based solid cosmetic compositions comprising one or more polyoxyalkylene modified silicones and one or more conventional cosmetically acceptable oils, pigments, and fillers. See abstract; Tables. The reference teaches that incorporation of a volatile oil to a cosmetic composition reduces glossy appearance and stability of the composition. See p. 2, lines 10 – 22. See p. 4, lines 45 – 47 and lines 52 – 54 for the types of fillers and the amount used. See instant claims 41, 42-45. The reference further teaches that the long wear of the composition results due to the increase in viscosity of polyether modified silicone in the composition upon the application on the skin, which holds the pigments more securely. See p. 5, lines 10

– 17. Thus it is inferred that no volatile oils are used in the Nojima transfer-resistant composition. Example 1 teaches a lipstick composition.

While Nojima generally teaches using hydrocarbon oils, the prior art does not limit the specific molecular weight range of the oils as claimed by applicants.

Mellul teaches a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil, MW 382.67), 0.1 % diphenyldimethicone (non alkoxyated non-volatile silicone oil), 5% alkyldimethicone (non-alkoxyated non-volatile silicone), 12 % pigments. See examples 5 and 6; instant claims 5-10, 62-69, 91-95, 103, 107. The reference teaches using octyldodecyl neopentanoate in 0.5-99 % by weight. See col. 2, lines 30 – 33; instant claims 32-35, 82. The reference teaches that octyldodecyl neopentanoate is “an excellent agent for compatibilizing silicone-containing compounds with each other, has good thermal and chemical stability, and makes it possible to obtain compositions with much oilier texture on application than comparison with compositions of the prior art not containing it”. See col. 2, lines 11 – 21. The reference further teaches that the ester has dispersant properties with respect to powders, and make it possible to make a homogeneous dispersion. See col. 2, lines 21 – 24. The reference also teaches using at least one silicone-containing compound such as polyimethylsiloxanes, alkyldimethicone, polyphenylmethylsiloxanes such as phenyldimethicones and phenyltrimethicones, and silicones modified with aliphatic and/or aromatic groups, which optionally contain fluorine, or with functional groups such as hydroxyl, thiol and/or amine groups. See col. 2, lines 47- col. 3, line 5; see Example 3.

While Mellul also mentions the functional equivalency of the above non-volatile silicone oils with cyclomethicones, which are volatile oils, it is noted that Nojima teaches that volatile oils reduce the glossiness and stability of the composition. It would have been obvious that a skilled artisan would have been motivated to select the non-volatile silicone oils from the Mellul teaching. See instant claims 102-112.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lipstick composition of Nojima by substituting the hydrocarbon oil in the formula with octyldodecyl neopentanoate as motivated by Mellul because the latter teaches that the ester is comparable with silicone, has good thermal and chemical stability, provides homogenous dispersion of pigments and oily texture on application. The skilled artisan would have had a reasonable expectation of successfully producing a stable lipstick composition because Nojima teaches to use hydrocarbon oil.

Claims 2-4, 11-19, 21-28, 36, 64, 71, 72, 74-79, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima and Mellul as applied to claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, and 101-112 above, and further in view of Jacks et al. (US 5690918).

Nojima and Mellul fail to teach non-volatile hydrocarbon oil having the MW limitation of instant claims 2-4 and the dispersant of the instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

Jacks teaches that it is well known in cosmetic art to use isononyl isononanoate (non volatile hydrocarbon oil, MW 284.48 g/mole) to make a lipstick composition. See

Example 2; instant claims 2-4. The reference also teaches using 10.34 % of diisoarachidyl dilinoleate (dispersant) in the lipstick formulation. See Example 2. See instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the lipstick composition of the combined references by substituting octyldodecyl neopentanoate and a diisoarachidyl dilinoleate with isononyl isononanoate as motivated by Jacks because the references are directed to lipstick formulations and Nojima and Jacks teach that these hydrocarbon oils are well known functional equivalents in lipstick art. The skilled artisan would have had a reasonable expectation of successfully producing a lipstick composition with similar effectiveness.

Claims 20 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima and Mellul as applied to claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, and 101-112 as above, and further in view of JP 63119412.

Mellul and Fogel, discussed above, do not teach poly(hydroxyl-12) stearic acid.

JP 63119412 abstract teaches 12-hydroxystearic acids is well known in lipstick art, and that the compositions having 12-hydroxystearic acid along with polyhydric alcohol esters of rosin, fatty acids with polyhydric alcohol gives improved luster and good dispersion of color. See abstract.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining

them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional lipstick agents. It would follow that the recited claims define prima facie obvious subject matter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added 12-hydroxystearic acid as motivated by JP 63119412 because of the expectation of successfully producing a lipstick composition with improved luster and good dispersion of color, as taught by the Japanese abstract.

Response to Arguments

Applicant's arguments filed on November 16, 2005 have been fully considered but they are not moot in view of new grounds of rejection in part and unpersuasive in part.

Applicants' arguments with respect to the rejection made in view of Mellul/Jacks/Fogel are moot as the rejection has been withdrawn in view of the claim cancellations.

With respect to claims 28, 79, 104, 108, applicants assert that Nojima fails to teach the specific silicones recited in the claims and that Mellul fails to teach a transfer-resistant composition. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the rejection is made based on what a skilled artisan would have known from the collective teachings of the references. Nojima teaches the disadvantage of using volatile oils in transfer-resistant lipsticks and Mellul teaches using the recited non volatile silicone oils in making cosmetic compositions. Thus it is viewed proper to conclude that a skilled artisan would have been motivated to use the specific non volatile silicone oils of Mellul to make the Nojima's transfer-free lipstick composition.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 7:00AM until 4:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner


SHENGJUN WANG
PRIMARY EXAMINER